

REMARKS

The undersigned would like to thank the Examiner for the courteous telephone interview extended to him on January 23, 2001. During that interview, the Examiner suggested re-writing the claims as apparatus claims in view of the undersigned's suggestion to add structural limitations to the claims so that they generally reflected the allowed claim subject matter in parent application 09/206,720, which was allowed by the Examiner on November 16, 2000 (Notice of Allowance attached as Appendix A). Thus, method claims 18, 19, and 22-38 have been cancelled and new apparatus claims 39-53 have been added in the present application.

Applicant respectfully requests reconsideration and allowance of the application in view of the included amendments and the following remarks.

New Claims:

Applicant respectfully submits that new claims 39-53 are in condition for allowance and such action is respectfully requested. Independent claim 39 generally corresponds to allowed claim 1 of parent application 09/206,720. A copy of claims 1, 2, 5-9, 23, 24, which were allowed in parent application 09/206,720, are in the attached September 14, 2000 Amendment (Appendix B). Claim 39 is different from claim 1 of parent application 09/206,720 in that

“a keel located between said bottom surface and said top surface of said metal board and defined by a continuous, closed cavity forming member extending substantially the length of the board; said keel having a height H1 and a width W2 and W2 is greater than H1; and a left rail and a right rail located between said bottom surface and said top surface adjacent said respective left and right edges and said rails defined by respective continuous, closed cavity forming members extending substantially the length of said metal board.”

from claim 1 is replaced with

multiple continuous, closed cavity forming members extending substantially the length of the board, at least one of the cavity forming members having a height H1 and a width W2 and W2 is greater than H1.

in claim 39.

However, claim 39 is in condition for allowance, because, as stated in the Examiner's Reasons For Allowance (Appendix A) in the 09/206,720 application, "The prior art references of record fail to teach each and every limitation of applicant's invention as claimed. Applicant's argument concerning the combinations of references set forth previously by the examiner have been considered and are persuasive. The examiner agrees with the applicant's statement that neither Houser ('157) nor Dickert ('900--both references cited previously) teach devices which would be considered skateboards corresponding to an art recognized definition. Further it does not appear that the device reference of Houser, while being aluminum, can be made by an extrusion process. While the reference to Smisek ('743--also cited previously) teaches the use of extruded channel sections (32) as elements to be added to a skateboard, the board itself is taught to be molded, and further would not admit of manufacture by extrusion, due to longitudinal discontinuities (as can be seen in ramps 30 and the ends of the internal channels, shown in figures 6a and 7). As dependent claims, 40-53 are also in condition for allowance.

Therefore, Applicant respectfully requests the allowance of claims 39-53.


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CONCLUSION

On the basis of the above amendments, reconsideration and allowance of the application is believed to be warranted and such action is respectfully requested. If the Examiner has any questions or comments regarding this amendment, he is respectfully urged to contact the undersigned at the number listed below.

Respectfully submitted,  
LYON & LYON LLP

By:

  
Stephen C. Beuerle  
Reg. No. 38,380

Date: February 5, 2001

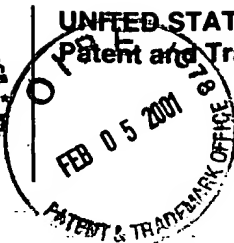
633 West Fifth Street, 47<sup>th</sup> Floor  
Los Angeles, CA 90071-2066  
(858) 552-8400

**APPENDIX A**

To: S. Benassi  
11/29/00



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office



# NOTICE OF ALLOWANCE AND ISSUE FEE DUE

PM82/1116

LYON & LYON  
JOHN M. BENASSI  
633 WEST FIFTH STREET  
SUITE 4700  
LOS ANGELES, CA 90071

RECEIVED

NOV 20 2000

U.S. PROSECUTION

APPLICATION NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
09/206,720	12/07/98	009	VANAMAN, F	3611 11/16/00
First Named Applicant	WILSON, 35 USC 154(b) term ext. = 0 Days.			

TITLE OF INVENTION EXTRUDED METAL SPORTS BOARD

ATTY'S DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEE DUE	DATE DUE
3 241/035	20WILSON/BOA	280-087.042	Z99 UTILITY	YES	\$620.00	02/16/01

**THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED.**

**THE ISSUE FEE MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.**

## HOW TO RESPOND TO THIS NOTICE:

### I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- A. If the status is changed, pay twice the amount of the FEE DUE shown above and notify the Patent and Trademark Office of the change in status, or
- B. If the status is the same, pay the FEE DUE shown above.

If the SMALL ENTITY is shown as NO:

- A. Pay FEE DUE shown above, or
- B. File verified statement of Small Entity Status before, or with, payment of 1/2 the FEE DUE shown above.

II. Part B-Issue Fee Transmittal should be completed and returned to the Patent and Trademark Office (PTO) with your ISSUE FEE. Even if the ISSUE FEE has already been paid by charge to deposit account, Part B Issue Fee Transmittal should be completed and returned. If you are charging the ISSUE FEE to your deposit account, section "4b" of Part B-Issue Fee Transmittal should be completed and an extra copy of the form should be submitted.

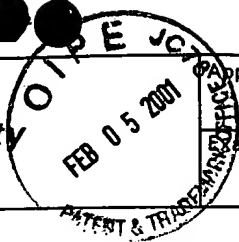
III. All communications regarding this application must give application number and batch number. Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.**

YOUR COPY

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# Notice of Allowability



Application No.  
09/206,720

Applicant(s)

Wilson et al.

Examiner

Frank Vanaman

Group Art Unit  
3611



All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course.

☒ This communication is responsive to amendments of Sept. 14, 2000 and Nov. 15, 2000.

☒ The allowed claim(s) is/are 1, 2, 5-9, 23, and 24

☒ The drawings filed on Dec 7, 1998 are acceptable.

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE THREE MONTHS FROM THE "DATE MAILED" of this Office action. Failure to timely comply will result in ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.

☐ Applicant MUST submit NEW FORMAL DRAWINGS

☐ because the originally filed drawings were declared by applicant to be informal.

☐ including changes required by the Notice of Draftsperson's Patent Drawing Review, PTO-948, attached hereto or to Paper No. \_\_\_\_\_

☐ including changes required by the proposed drawing correction filed on \_\_\_\_\_, which has been approved by the examiner.

☐ including changes required by the attached Examiner's Amendment/Comment.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the reverse side of the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any response to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☐ Interview Summary, PTO-413

☒ Examiner's Amendment/Comment

☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material

☒ Examiner's Statement of Reasons for Allowance

Art Unit: 3611

### **Examiner's Amendment**

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Stephen Beuerle on Nov. 14, 2000.

2. The application has been amended as follows:

In claim 1, line 1, --adapted to be-- has been inserted between "is" and "ridden".

3. This amendment has been made for the purposes of insuring clarity in the claim scope.

### **Reasons for Allowance**

4. The following is an examiner's statement of reasons for allowance: The prior art references of record fail to teach each and every limitation of applicant's invention as claimed. Applicant's arguments concerning the combinations of references set forth previously by the examiner have been considered and are persuasive. The examiner agree with applicant's statement that neither Houser ('157) nor Dickert ('900-- both references cited previously) teach devices which would be considered skateboards corresponding to an art recognized definition. Further it does not appear that the device reference of Houser, while being aluminum, can be made by an extrusion process. While the reference to Smisek ('743-- also cited previously) teaches the use of extruded channel sections (32) as elements to be added to a skateboard, the board itself is taught to be molded, and further would not admit of manufacture by extrusion, due to longitudinal discontinuities (as can be seen in the ramps 30 and the ends of the internal channels, shown in figures 6a and 7).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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Art Unit: 3611

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Vanaman whose telephone number is (703) 308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Assistant Commissioner for Patents  
Washington, DC 20231

or faxed to :

(703) 305-3597 or 305-7687 (for formal communications intended for entry;  
informal or draft communications may be faxed to the same number but should be  
clearly labeled "UNOFFICIAL" or "DRAFT")

**FRANK B. VANAMAN**  
**Patent Examiner**  
**Art Unit 3611**

November 15, 2000

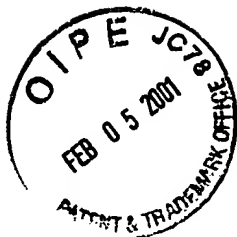


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**APPENDIX B**



Patent  
241/035

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Wilson et al.**

**Serial No.:** 09/206,720

**Filed:** 12/07/98

**For: EXTRUDED METAL  
SKATEBOARD**

)  
) **Group Art Unit:** 3611

)  
) **Examiner:** F. Vanaman

AMENDMENT

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

In response to the Office Action mailed August 10, 2000, Applicants respectfully request reconsideration and allowance of the present application in view of the following remarks:

IN THE CLAIMS:

Please amend claim 1 as follows:

1. (Amended) A skateboard that is ridden by a [person]user standing upon it, comprising: an elongated extruded aluminum metal board; said metal board having a front end, a rear end, a top surface, a bottom surface, a left edge, [and] a right edge, and a width adapted to accommodate the

CERTIFICATE OF MAILING  
(37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231.

\_\_\_\_\_  
Date of Deposit

\_\_\_\_\_  
Name of Person Mailing Paper

\_\_\_\_\_  
Signature of Person Mailing Paper

user's feet in a direction generally perpendicular to the longitudinal axis of the board; a keel located between said bottom surface and said top surface of said metal board and defined by a continuous, closed cavity forming member extending substantially the length of the board; said keel having a height H1 and a width W2 and W2 is greater than H1; and a left rail and a right rail located between said bottom surface and said top surface adjacent said respective left and right edges and said rails defined by respective continuous, closed cavity forming members extending substantially the length of said metal board.

2. (Recited) A skateboard as recited in claim 1 wherein said keel has a substantially rectangular cross-sectional configuration.

Please cancel claim 4.

5. (Recited) A skateboard as recited in claim 1 wherein said metal board has an arcuate shaped front end and an arcuate shaped rear end.

6. (Recited) A skateboard as recited in claim 5 wherein plastic end guards are secured to said front and rear ends of said metal board.

7. (Recited) A skateboard as recited in claim 1 wherein said top surface of said metal board has a concave transverse contour.

8. (Recited) A skateboard as recited in claim 1 wherein said metal board has a bent-up front tip portion and a bent-up rear tip portion.

9. (Recited) A skateboard as recited in claim 1 further comprising front and rear skateboard trucks secured to said bottom surface of said metal board.

23. (Recited) A skateboard as recited in claim 1, wherein said board deflects less than 0.162 in. with a load of 200 lbs.

24. (Recited) A skateboard as recited in claim 1, wherein said board deflects less than 0.203 in. with a load of 250 lbs.

### REMARKS

Applicants would like to thank the Examiner for the courteous interview extended to their attorney on September 12, 2000. During that interview, Applicants' attorney and the Examiner agreed that at least the addition of "extruded" to independent claim 1 would define over the Houser reference.

Claims 1, 2, 5-9, 23, and 24 are pending in the present application. All of these claims stand rejected under 35 U.S.C. 103(a). Claim 4 has been cancelled. Claim 1 has been amended to further clarify the subject matter that Applicants regard as the invention. Applicants respectfully request reconsideration and allowance of the above-identified application in view of the above amendments and the following remarks.

#### 35 U.S.C. §103, Houser in view of Dickert

In regard to the rejection of claims 1, 2, 5, 8, 9, 23 and 24 as being unpatentable over Houser in view of Dickert, Applicants respectfully traverse this rejection because the cited combination of these references does not achieve the claimed invention. The claimed skateboard includes, among other features that have been discussed at length during the prosecution of the present application, an extruded aluminum metal board with a width adapted to accommodate the user's feet in a direction generally perpendicular to the longitudinal axis of the board. In contrast, Houser and Dickert do not relate to a skateboard including an extruded aluminum metal board, but to non-extruded water skis and snow skis, respectively. Not only are water skis and snow skis different from skateboards, the dynamic action of skiing, or gliding, is nonanalogous to the dynamic action of skateboarding. Skiing requires the rider to bind each foot longitudinally parallel to a separate ski, so the skis act as extensions of the rider's feet. Skateboarding, in contrast, typically requires the rider to stand, with feet unbound, on a single skateboard with both feet generally perpendicular to the longitudinal axis of the skateboard, so the skateboard acts as an independent vehicle wholly separate from the rider. While gliding (or "skiing") the rider moves smoothly and effortlessly, as over snow or water,

skateboarding requires the rider to remove one foot from the skateboard and push against the riding surface in order to propel the skateboard. Further, skateboards are adapted to be ridden on a hard surface, i.e., cement or pavement compared to water/snow, and undergo much greater stress during normal activity than a water ski or snow ski because of the harder surface that the skateboard is ridden on. Further, skateboards are frequently used for jumping onto such a surface or other surfaces. Thus, the water ski and snow ski teachings of Houser and Dickert, respectively, are not applicable to skateboards and the combination of these references does not achieve the claimed invention. Therefore, Applicants respectfully request that this rejection be withdrawn.

In regard to claims 5 and 8, Dickert in combination with Houser does not disclose, teach, or suggest an arcuate shaped front end and an arcuate shaped rear end, and a bent-up front tip portion and a bent-up rear tip portion, further evidencing that these references do not relate to skateboards.

In regard to claims 23 and 24, Dickert in combination with Houser does not disclose, teach, or suggest a skateboard with these particular force-to-deflection characteristics. These force-to-deflection characteristics are possible as a result of the particular skateboard structure recited in claim 1 and are desirable qualities for a skateboard to have in view of the greater stress that skateboards undergo on harder surfaces, i.e., cement or pavement compared to water/snow. Dickert in combination with Houser does not disclose, teach, or suggest a skateboard, and especially does not disclose, teach, or suggest these force-to-deflection characteristics.

Therefore, Applicants respectfully submit that claims 1, 2, 5, 8, 9, 23 and 24 are not obvious over Houser in view of Dickert because the combination of Houser and Dickert does not achieve the claimed skateboard. Applicants respectfully request that this rejection be withdrawn.

35 U.S.C. §103, Houser as modified by Dickert, in further view of Joyce

In regard to the rejection of claim 6 as being unpatentable over Houser as modified by Dickert, in further view of Joyce, Applicants respectfully submit that these claims are not obvious for the reasons given above with respect to Houser in view of Dickert. Joyce also does not disclose, teach, or suggest a skateboard. Moreover, proper motivation does not exist to combine Joyce with Houser and Dickert. The bumper of Joyce is used to protect buoyant fiberglass or wooden surfboards from submarine impacts typically encountered while surfing. In contrast, the water ski of

Houser is made of a much more durable material (aluminous metal) than that used in Joyce and is not prone to the same types of problems caused by submarine impacts. Therefore, Applicants respectfully submit that claim 6 is not obvious over Houser in view of Dickert and further in view of Joyce because the combination does not achieve the claimed skateboard, and proper motivation does not exist to combine Joyce with Dickert and Houser. Applicants respectfully request that this rejection be withdrawn.

35 U.S.C. §103, Houser as modified by Dickert, in further view of Schorr

In regard to the rejection of claim 7 as being unpatentable over Houser as modified by Dickert, in further view of Schorr, Applicants respectfully submit that this claim is not obvious for the reasons given above with respect to Houser in view of Dickert. Applicants respectfully request that this rejection be withdrawn.

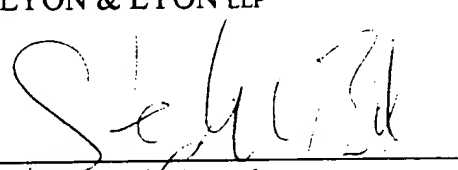
**CONCLUSION**

On the basis of the above remarks, reconsideration and allowance of the application is believed to be warranted and such action is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully urged to contact the undersigned at the number listed below.

Respectfully submitted,

LYON & LYON LLP

By: \_\_\_\_\_

  
Stephen C. Beuerle  
Reg. No. 38,380

Dated: September 14, 2000

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Los Angeles, California 90071-2066  
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